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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT KEANE,
ERIK ROBERTSON, and
SEBASTIEN COURSOL

Appeal 2009-005940
Application 10/608,981
Technology Center 3600

Decided: March 2, 2010

Before HUBERT C. LORIN, BIBHU R. MOHANTY, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

Opinion for the Board filed by LORIN, *Administrative Patent Judge*.

Opinion Dissenting and Concurring filed by FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Robert Keane et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-8. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

This invention is an apparatus that includes “web browsers configured for interactive design by users of discrete print jobs.” Specification 8:13-14.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented product design method comprising
 - providing one or more design software tools, the tools being adapted to
 - (a) allow a user to create an electronic product design and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement.

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Feb. 4, 2008) and Reply Brief (“Reply Br.,” filed Jun. 30, 2008), and the Examiner’s Answer (“Answer,” mailed Apr. 29, 2008).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Ryan

US 6,173,274 B1

Jan. 9, 2001

The Examiner took official notice that “it is old and well known in the promotion art that manufacturers pay to insert their ads in flyers or printed papers.” Answer 5. [Hereinafter Official Notice I].

The Examiner took official notice that “it is old and well known in the promotion art that advertisers offer consumers, products and services for free when said consumers accept to view or display advertisements in said products.” Answer 6. [Hereinafter Official Notice II].

The following rejections are before us for review:

1. Claims 1-3, 5, 7, and 8 are rejected under 35 U.S.C. §102(e) as being anticipated by Ryan.
2. Claim 4 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan and Official Notice I.
3. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan and Official Notice II.

ISSUES

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1-3, 5, and 7 under 35 U.S.C. §102(e) as being anticipated by Ryan. Specifically, whether Ryan describes: 1) a product design software tool adapted to allow a user to create an electronic product design, 2) the product design software tool being adapted to incorporate into the design an advertisement not provided by the user, and 3)

the product design software tool being adapted to offer the user the option of removing the advertisement.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claim 2 under 35 U.S.C. §102(e) as being anticipated by Ryan. Specifically, whether Ryan describes the product design software tool that is adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template.

The third issue is whether the Appellants have shown that the Examiner erred in rejecting claim 3 under 35 U.S.C. §102(e) as being anticipated by Ryan. Specifically, whether Ryan describes that the user must pay a fee to have the advertisement removed.

The fourth issue is whether the Appellants have shown that the Examiner erred in rejecting claim 8 under 35 U.S.C. §102(e) as being anticipated by Ryan. Specifically, whether Ryan describes that the electronic product design prepared by a user and that the advertising that is incorporated into the electronic product design is not provided by the user.

The fifth issue is whether the Appellants have shown that the Examiner erred in rejecting claim 4 under 35 U.S.C. §103(a) as being unpatentable over Ryan and Official Notice I.

The sixth issue is whether the Appellants have shown that the Examiner erred in rejecting claim 6 under 35 U.S.C. §103(a) as being unpatentable over Ryan and Official Notice II.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification does not contain an express definition of “design.”
2. A definition of “design” is “something *designed*; plan, pattern, etc.” *The Pocket Webster School & Office Dictionary*, p. 207 (1990).
3. The Specification does not contain an express definition of “template.”
4. A definition of “template” is “a mold or pattern.” *The Pocket Webster School & Office Dictionary*, p. 207 (1990).
5. We adopt the Examiner’s finding of facts with regards to the disclosure of Ryan. Answer 3-6.

PRINCIPLES OF LAW

Claim Construction

During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with

only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003).

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the

circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-3, 5, 7, and 8 under §102(e) as being anticipated by Ryan.

Claims 1 and 5- 7

The Appellants argued claims 1, 5, and 7 as a group (App. Br. 10-15). We select claim 1 as the representative claim for this group, and the remaining claims 5 and 7 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2009).

The Appellants argue that Ryan does not anticipate claim 1 because Ryan does not describe: 1) a product design software tool adapted to allow a user to create an electronic product design, 2) the product design software tool being adapted to incorporate into the design an advertisement not provided by the user, and 3) the product design software tool being adapted to offer the user the option of removing the advertisement.

First, the Appellants argue that Ryan does not describe a product design software tool that is adapted to allow a user to create an electronic product design. App. Br. 12-13 and Reply Br. 4-5. The Appellants state,

Importantly, however, the data processing system 80 does not create or generate an electronic product design. There is no teaching or suggestion in Ryan that the data processing system 80 creates, either by itself or under the direction of the user, an actual electronic product design. Rather, Ryan’s data processing system 80 creates only a control code.

App. Br. 13. The Examiner asserts that the data processing system 80 in Ryan is a user tool that creates an electronic product design, such as for high volume mail-pieces. Answer 7.

We agree with the Examiner. We find nothing in claim 1 that prevents the limitation from reading on Ryan's data processing system 80. As the Appellants state, a user uses data processing system 80 to create a control code 82. App. Br. 13. Control code 82 can be considered the claimed "electronic product design." We note that the Specification does not contain an express definition of "design." FF 1. Giving "design" the broadest reasonable meaning in light of the Specification, we construe "design" to mean "a plan or pattern." FF 2.

The control code 82 can be considered a plan, since it provides instruction on how to create a mail-piece (*i.e.* a product). *See* Ryan col. 5, ll. 41-46. Ryan describes that control code 82 includes a message indicator (Ryan col. 12, ll. 37-43), which is then used by the insert system 300 to print the message on the envelope (Ryan col. 12, ll. 45-47). Ryan states, "[t]he message indicator may identify a selected graphic file previously stored in memory 386 for use in printing the selected message 70. On the other hand the message indicator may contain sufficient graphic data so that reference to an external file is not necessary." Ryan: Col. 12, ll. 49-53. Further, we note that Ryan describes allowing the user to select which ad zone the message may be printed in. Ryan: Col. 11, ll. 1-5. Control code 82 is an electronic product design for printing the mail-pieces. Therefore, we find that the Appellants have not shown that the Examiner erred in finding that Ryan describes providing a product design software tool, which is adapted to allow a user to create an electronic product design.

Second, the Appellants argue that Ryan does not describe a product design software tool that is adapted to incorporate into the design of an advertisement not provided by the user. App. Br. 13-14. Specifically, the Appellants argue that the advertisement in Ryan *is* provided by the user. App. Br. 13-14. The Appellants state,

in Ryan's system, it is the user, and not the data processing system 80 software tool itself or the third party advertisers, that selects the message to be printed, and therefore it is the user that provides a message for incorporation into the items to be printed on the envelope.

App. Br. 13. The Examiner asserts that Ryan's advertisements are provided by a third-party and not by the user. Answer 8.

We agree with the Examiner. Claim 1 does not recite any limitations as to when or how the advertisement is provided. Nor does claim 1 recite any limitation as to whom or what the advertisement is provided and it does not require that the advertisement be provided at the time of designing the product. Claim 1 merely recites that the advertisement is not provided by the user and encompasses an advertisement provided by a third-party advertiser to the data processing system at a time prior to designing the product, as in Ryan. *See* Ryan col. 9, ll. 42-45. Therefore, we find that the Appellants have not shown that the Examiner erred in finding that Ryan describes providing a product design software tool, which is adapted to incorporate into the design an advertisement not provided by the user.

Finally, the Appellants argue that Ryan does not describe a product design software tool that is adapted to offer the user the option of removing the advertisement. App. Br. 14. The Appellants state, "[i]n Ryan, the user must actively select a message to incorporate into the printed envelope." App. Br. 14. The Examiner asserts that Ryan describes this limitation in

column 9, lines 10-30, which describes giving the user the option to restrict the specific mail-pieces the advertisement would be printed on. Answer 9.

We agree with the Examiner. We note that claim 1 does not recite any limitations as to how or when the offer is made to remove the advertising. Claim 1 merely requires that the tool is adapted to offer the user the option of removing the advertisement. Ryan states “[t]he restriction data 804(c) may indicate in advance those particular recipient addresses 50 where third party advertising is not allowed.” Ryan col. 9, ll. 26-28. Further, Ryan describes establishing a user data profile 804 for each user and allowing each user to set parameters, such as preference data 804(b), for controlling third party advertising. Ryan col. ll. 59-67. Ryan states “[t]he preference data 804(b) includes an indicator of whether the user allows third party advertising at all. In this manner, the user may by-pass the third party advertising system in its entirety.” Ryan col. 9, ll. 13-16. Given the above descriptions, we find that Ryan describes a tool that is adapted to offer the user the option of removing the advertisement. Therefore, we find that the Appellants have not show that the Examiner erred in finding that Ryan describes providing a product design software tool, which is adapted to offer the user the option of removing the advertisement.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 1, and claims 5 and 7, dependent thereon, under 35 U.S.C. §102(e) as being anticipated by Ryan.

Claim 2

Claim 2 recites that the tool is “adapted to provide a product template to the user and allow the user to incorporate user content into the template to

create the electronic product design and wherein the advertisement is incorporated into the template.” The Appellants argue that Ryan does not anticipate claim 2 because Ryan does not describe a product template. App. Br. 16. The Examiner asserts that Ryan teaches allowing users to incorporate user data such as addresses into a template to create a mail-piece and points to Figure 3. Answer 13. The Appellants respond that Figure 3 does not depict a template but instead depicts a front view of an envelope that has been processed by the production mail system. Reply Br. 7-8.

We agree with the Appellants. Ryan does not expressly describe that the data processing system 80 is adapted to provide a product template to the user. Initially, we note that an ordinary and customary meaning of “template” is “mold or pattern.” FF 4. *See also* FF 3. First, we agree with the Appellants that Figure 3 does not depict a product template that is provided to the user as the Examiner has asserted but instead depicts a finished product. *See* Ryan col. 4, ll. 57-59. Second, while Ryan does describe that the data processing system 80 operates under the control of the user (Ryan col. 5, ll. 31-32) and that user data in the data processing system 80 can include data that indicates the content and placement of the printing on the envelope (Ryan col. 7, l. 59 - col. 8, l. 41), Ryan is silent as to how the user enters the data into the data processing system 80.

Accordingly, even when the claim is construed reasonably broadly, Ryan does not expressly describe a product template is presented to a user. Further, providing a product template to a user is not an inherent function of or necessarily flow from employing the data processing system 80. Nothing disclosed in Ryan would lead one of ordinary skill in the art to reach that conclusion. Ryan nowhere explains the data processing system 80 so that

one of ordinary skill in the art would understand it is necessarily capable of providing a product template to the user. While it is possible to make the data processing system 80 have that capability, inherency may not be established by possibilities. “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted) (internal quotation marks omitted).

Because Ryan fails to describe, expressly or inherently, the subject matter of claim 2, we find that the Appellants have shown that the Examiner erred in rejecting claim 2 under 35 U.S.C. §102(e) as being anticipated by Ryan.

Claim 3

The Appellants argue that Ryan does not describe that the user must pay a fee to have the advertisement removed as recited in claim 3. App. Br. 17. Appellants assert that Ryan instead describes paying the user via a subsidy or invoice credit to print the advertisement. App. Br. 17. The Examiner asserts Ryan anticipates this limitation because Ryan describes the user paying a full price fee for mail-pieces that do not include advertisements. Answer 13.

We agree with the Examiner. Claim 3 does not recite limitations as to how the fee to remove the advertisement is charged or collected. Claim 3

does not require the fee be collected or charged separately from the fees for providing other services. Claim 3 encompasses paying a fee to remove the advertisement by paying a full price fee as described in Ryan. *See* Ryan col. 12, l. 60 - col. 13, l. 10. Therefore, we find that the Appellants have not show that the Examiner erred in finding that Ryan describes providing a product design software tool, which is adapted to offer the user the option of removing the advertisement.

Claim 8

For the same reasons as discussed above with regards to claim 1, the Appellants assert that Ryan does not describe an electronic product design prepared by a user and an advertisement that is incorporated into the electronic product and that is not provided by the user. App. Br. 17. Accordingly, because we found Appellants' arguments unpersuasive as to the rejection of claim 1, we find them equally unpersuasive as to error in the rejection of claim 8. We find that the Appellants have not shown that the Examiner erred in rejecting claim 8 under 35 U.S.C. §102(e) as being anticipated by Ryan.

The rejection of claim 4 under §103(a) as being unpatentable over Ryan and Official Notice I.

In addition to the arguments made with respect to claim 1, the Appellants argue that Ryan does not teach “wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools.” App. Br. 18. Specifically, the Appellants argue that Ryan does not teach ‘any

advertisement being for the company that is providing the advertisement selection system described at col. 12, lines 23-29 in connection with printing the user's envelope." App. Br. 18. Further, the Appellants argue that Official Notice I does not address this limitation. Reply Br. 9.

The Appellants' argument does not address the Examiner's rationale in combining Ryan and Official Notice I to establish a prima facie showing that claim 4 obvious. The Examiner combined Ryan with Official Notice I to teach this limitation and concluded the postage meter manufactures in Ryan would be motivated to pay users for inserting the manufactures' ads onto the envelopes. Answer 5-6. The combination suggested by the Examiner would result in the advertisement in Ryan being for the postage meter manufacturer, who provides the postage meter. The Appellants' arguments do not address the combination made by the Examiner.

Accordingly, we find that the Appellants have not shown that the Examiner erred in rejecting claim 4 under 35 U.S.C. §103(a) as being unpatentable over Ryan.

The rejection of claim 6 under §103(a) as being unpatentable over Ryan and Official Notice II.

The Appellants argue against the rejection of claim 6 for the same reasons used to argue against the rejection of claim 1. App. Br. 18. Accordingly, because we found them unpersuasive as to that rejection, we find them equally unpersuasive as to error in the rejection of claim 6. We find that the Appellants have not shown that the Examiner erred in rejecting claim 6 under §103(a) as being unpatentable over Ryan and Official Notice II.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1, 3, 5, 7, and 8 under 35 U.S.C. §102(e) as being anticipated by Ryan and claims 4 and 6 under 35 U.S.C. §103(a) as being unpatentable over Ryan. We conclude that the Appellants have shown that the Examiner erred in rejecting claim 2 under 35 U.S.C. §102(e) as being anticipated by Ryan.

DECISION

The decision of the Examiner to reject claims 1 and 3-8 is affirmed and to reject claim 2 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

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CONCURRING AND DISSENTING OPINION

FREDMAN, *Administrative Patent Judge*, concurring-in-part and dissenting-in-part.

I concur with the majority regarding the affirmance of the rejection of claims 1-3, 5, 7, and 8 under 35 U.S.C. §102(e) as being anticipated by Ryan and the affirmance of the rejection of claims 4 and 6 under 35 U.S.C. §103(a) as being unpatentable over Ryan.

I respectfully dissent from the majority regarding the reversal of the rejection of claim 2 under 35 U.S.C. §102(e) as being anticipated by Ryan. I would affirm the Examiner's anticipation rejection of claim 2, based upon the Examiner's reasoning and the following comments.

I think that the majority has arrived at an incorrect result in this case based upon narrowly interpreting the limitation in Claim 2 to "provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design" in a manner that is inconsistent with the broadest reasonable interpretation in light of the Specification.

ADDITIONAL FINDINGS OF FACT

6. The Specification teaches that print orders can be placed from a variety of entry ports, and that the "types of entry ports could include home office/small computer entry ports . . . Other entry ports need not be based on web browsers, but could be, for example email links 15d and dial up telephone lines 15e. The system can also be integrated with bidding systems". Spec. 10, l. 22 to 11, l. 4.

7. The Specification teaches that “[o]ther entry ports do not even require that the customer have access to a browser, *e.g.*, a dial-up voice telephone link 15e could be used to enter information by voice or punching keys on the telephone keypad”. Spec. 14, ll. 23-25.

8. Ryan teaches that the “data processing system 80 is typically operated under the control of a user that produces high volume mailpieces for billing purposes . . . or for statement purposes”. Ryan, col. 5, ll. 31-34.

9. Ryan teaches that “[g]enerally, the user’s host application software collects and organizes various information relating to individual accounts that customers maintain with the user”. Ryan, col. 5, ll. 34-38.

10. Ryan teaches that “the user may optionally place a sender or return address 40 in the upper left hand corner of the envelope 20”. Ryan, col. 7, ll. 27-29.

11. Ryan teaches that
a respective user data profile 804 is established for each
of the individual user accounts and allows each user to set
parameters for controlling third party advertising on their
respective envelopes 20. This may be accomplished at the time
when the user opens up an account with the data center 200 or
at any other mutually convenient occasion.
Ryan, col. 8, ll. 59-65.

12. Ryan teaches that “once the available messages are determined, the relevant messages and their corresponding subsidy rate 807*b* are presented to the user on the data processing system 80. This provides the user with the opportunity to view and analyze the available messages along with their corresponding subsidy rate 807*b*”. Ryan, col. 12, ll. 23-28.

13. Ryan teaches that “[n]ext, at 612, the user selects a message for printing on the envelope 20”. Ryan, col. 12, ll. 28-29.

ANALYSIS

The Majority reverses the Ryan anticipation rejection over Claim 2, based upon Appellants argument that “Ryan’s data processing system 80, however, does not provide a design tool that provides a product template to a user, or any functionality for incorporating user-provided content into the template”. App. Br. 16. The Majority concludes that “Ryan is silent as to how the user enters the data into the data processing system 80. Ryan is silent as to whether a product template is presented to a user. Further, we find that it is not inherent that the data processing system 80 presents a product template to the user”. Dec. *see supra*.

I disagree with these factual findings and the resultant conclusion. Appellants Specification, and more importantly, Claim 2, do not require any particular mode in which the product template is provided to the user and do not require any particular mode by which the user incorporates content. *see* FF 6-7, Claim 2. Therefore Claim 2 is open to any mode of providing the product template to the user.

It is black letter law that
the PTO gives a disputed claim term its broadest reasonable interpretation during patent prosecution” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). The court recognizes the fairness of reading claims broadly “before a patent is granted [since] the claims are readily amended as part of the examination process. *Burlington Indus. v. Quigg*, 822 F.2d 1581, 1583 (Fed.Cir.1987).

Thus, a patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application”. *Bigio*, 381 F.3d at 1324. Applying the broadest reasonable interpretation to claims also “serves the public

interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.

In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364 (Fed.Cir.2004).

In my view, Ryan expressly teaches manipulation of the product template, which in Ryan's disclosure relates to preparation of envelopes for mailing, by the user. Ryan teaches that data processing system 80 is under user control (FF 8-9) and that that "the user may optionally place a sender or return address 40 in the upper left hand corner of the envelope 20" (Ryan, col. 7, ll. 27-29; FF 10).

Ryan teaches that the user maintains control over the advertising (FF 11) and Ryan expressly teaches that "once the available messages are determined, the relevant messages and their corresponding subsidy rate 807b are presented to the user on the data processing system 80. This provides the user with the opportunity to view and analyze the available messages along with their corresponding subsidy rate 807b" (Ryan, col. 12, ll. 23-28; FF 12).

I conclude that Ryan's teaching of the selection of the return address (FF 10) and Ryan's teaching to present the "available messages" of advertising to the user (FF 12) both require providing information regarding the product "template" to the user.

While I agree with the majority that Ryan does not teach precisely how this presentation to the user is implemented, since Ryan teaches that the user maintains this control, I find that Ryan necessarily functions as required by Claim 2. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed.Cir.2002) ("It is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it. Under the principles of inherency, if the prior art

Appeal 2009-005940
Application 10/608,981

necessarily functions in accordance with, or includes, the claimed limitations, it anticipates.”). I would therefore affirm the Examiner’s rejection of Claim 2.

For these reasons, I respectfully dissent.

mev

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